

Hearing:  
September 22, 1999

Paper No. 57  
JQ

THIS DISPOSITION IS NOT CITABLE AS  
PRECEDENT OF THE TTAB MAY 25, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

Zelco Industries, Inc.  
v.  
Diamond Brands Incorporated

---

Cancellation No. 20,485

---

Request for Reconsideration

---

Robert B.G. Horowitz and Donna A. Tobin of Cooper & Dunham  
for Zelco Industries, Inc.

Paul M. Denk for Diamond Brands Incorporated.

---

Before Quinn, Hohein and Bottorff, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

The Board, in a decision dated March 22, 2000, granted  
the petition for cancellation of Registration No. 1,662,173  
on the ground of likelihood of confusion.

Respondent has filed a request for reconsideration.  
Respondent asserts that the Board "apparently did not  
address an issue which, frankly, was Respondent's primary

issue in this case." (request, p. 1) Respondent essentially contends that petitioner's claim of priority is erroneously based on licensed use which, during the time prior to respondent's use, was inuring to the benefit of a third party.

Petitioner has filed a brief in opposition to respondent's request.

We share petitioner's surprise at respondent's characterization of this issue as its "primary issue" in the case. As pointed out by petitioner, respondent's remarks directed to petitioner's use consisted of barely one page in its sixteen-page brief on the case. Moreover, contrary to respondent's contention, the Board did, in fact, address the issue upon which the request for reconsideration is based. In the Board's original decision, it was determined that petitioner's own use of the mark SUPERMATCH began in 1980, and that petitioner and a third party (BAM Butane) subsequently "entered into an agreement whereby petitioner continued using the mark to petitioner's own benefit." (decision, p. 7)<sup>1</sup> The Board further took note that under the terms of the agreement, in the event BAM ceased use of the mark for a period of two

---

<sup>1</sup> Page 7 of the original decision is corrected to indicate that BAM's registration was canceled in May 1987 (not, as incorrectly set forth, in 1990).

years, all rights in the mark were to be owned by petitioner.

More significantly, the request is not well taken on the merits. As recounted in detail by petitioner in opposing reconsideration, petitioner's use of the mark pursuant to its agreement with BAM inured to petitioner's benefit. And, even assuming arguendo that petitioner's use of the mark inured to BAM's benefit during the term of the agreement, petitioner still has priority of use, by operation of the agreement, by virtue of BAM's rights in the mark reverting to petitioner no later than May 1989, that is, at a point in time that is prior to the earliest date upon which respondent has established.

Accordingly, for the very reasons detailed in petitioner's brief opposing reconsideration, respondent's request for reconsideration is denied.

T. J. Quinn

G. D. Hohein

C. M. Bottorff  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board